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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,493	09/23/2003	Gil M. Vardi	CWIRE-001DIV	3988

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EXAMINER
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FOREMAN, JONATHAN M

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/669,493

Applicant(s)

VARDI ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15 - 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15 - 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 15, 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,068,623 to Zadno-Azizi et al. in view of U.S. Patent No. 5,144,959 to Gambale et al.

In regards to claims 15, 17, 18 and 20, Zadno-Azizi et al. discloses providing a guidewire (12) having a core wire with a proximal section and distal section at least partially defining a distal outer surface of the guidewire, and plating gold into indentations at a plurality of predetermined locations of the core (Col. 8, lines 58 - 62) to provide a plurality of equally spaced radiopaque markers (Col. 8, lines 45 - 47). The indentations allow for a substantially smooth outer surface (Col. 8, lines 60 - 62). Zadno-Azizi et al. discloses a lubricious coating (Col. 7, lines 28 - 30). However, Zadno-Azizi et al. fails to disclose coating portions of the distal section of the core wire with a mask; exposing the distal portion beneath the mask at a plurality of predetermined locations; electroplating gold onto the predetermined locations; and removing the mask. However, Gambale et al. discloses coating portions of a distal section of the guidewire with a mask; exposing the distal portion beneath the mask at a plurality of predetermined locations (Col. 5, lines 47 - 52); electroplating gold onto the predetermined locations (Col. 5, lines 35 - 37; Col. 4, lines 17 - 21); and removing the mask (Col. 5, lines 53 - 54). It would have been obvious to one having ordinary skill in the art to use the method as taught by Gambale et al. for plating gold at a plurality of predetermined locations of the distal

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section of the guidewire to plate gold at a plurality of predetermined locations of the distal section of the core wire as disclosed by Zadno-Azizi et al. to ensure that plating is only deposited on the desired areas.

3. Claims 15, 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,068,623 to Zadno-Azizi et al. in view of U.S. Patent No. 6,174,329 to Callol et al.

In regards to claims 15, 17, 18 and 20, Zadno-Azizi et al. discloses providing a guidewire (12) having a core wire with a proximal section and distal section at least partially defining a distal outer surface of the guidewire, and plating gold into indentations at a plurality of predetermined locations of the core (Col. 8, lines 58 - 62) to provide a plurality of equally spaced radiopaque markers (Col. 8, lines 45 - 47). The indentations allow for a substantially smooth outer surface (Col. 8, lines 60 - 62). Zadno-Azizi et al. discloses a lubricious coating (Col. 7, lines 28 - 30). However, Zadno-Azizi et al. fails to disclose coating portions of the distal section with a mask; exposing the core wire at a plurality of predetermined locations beneath the mask; electroplating gold onto the predetermined locations; and removing the mask. Callol et al. discloses a method for manufacturing an intraluminal device including coating portions of the device with a mask (Col. 6, lines 8 - 10); exposing the core wire at a plurality of predetermined locations beneath the mask (Col. 6, lines 12 - 15); and electroplating gold onto the predetermined locations (Col. 6, lines 16 - 18). The mask is inherently removed before using the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the steps of coating a portion of the distal section of the guidewire as disclosed by Zadno-Azizi et al. with a mask; exposing the core wire at a plurality of predetermined locations beneath the mask; electroplating gold onto the predetermined locations; and removing the mask as taught by Callol et al. in order to ensure the correct positioning of the radiopaque material at the desired locations on the guidewire.

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4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,068,623 to Zadno-Azizi et al. in view of U.S. Patent No. 5,144,959 to Gambale et al. as applied to claim 15 above, and further in view of U.S. Patent No. 5,406,960 to Corso, Jr.

In regards to claim 16, Zadno-Azizi et al. in view of Gambale et al. fail to disclose the distal section of the core wire containing the plurality of spaced apart makers having a constant diameter and not being tapered toward the distal end. However, Corso, Jr. discloses a guide wire wherein the distal section of the core wire containing the plurality of spaced apart makers has either a constant diameter or is tapered toward the distal end (Col. 4, line 65 – Col. 5, line 6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the constant diameter distal section as disclosed by Zadno-Azizi et al. in view of Gambale et al. to taper toward the distal end in that Corso, Jr. teaches a constant diameter and a taper as being equivalent and therefore interchangeable.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,068,623 to Zadno-Azizi et al. in view of U.S. Patent No. 5,144,959 to Gambale et al. as applied to claim 15 above, and further in view of U.S. Patent No. 6,455,783 to Tsukada et al.

In regards to claim 19, Zadno-Azizi et al. in view of Gambale et al. discloses removing the mask (Col. 5, lines 53 – 54), but fails to disclose chemically dissolving the mask. However, Tsukada et al. discloses an electroplating process wherein the mask is removed by chemically dissolving the mask (Col. 8, lines 55 – 56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to remove the mask as disclosed by Zadno-Azizi et al. in view of Gambale et al. by chemically dissolving the mask as taught by Tsukada et al. so as to remove the mask in its entirety.

***Response to Arguments***

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JMLF

  
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